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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/675,665	07/03/96	VAN DER HOOFDEN J	PHN-15.364

EXAMINER

B2M1/0303

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ART UNIT	PAPER NUMBER
2502	11

DATE MAILED: 03/03/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 12-8-1997

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), ~~or thirty days~~, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1, 2, 4-6 is/~~are~~ pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☒ Claim(s) 1, 2, 4-6 is/~~are~~ rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.
☐ received in Application No. (Series Code/Serial Number) _____.
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
☐ Interview Summary, PTO-413
☐ Notice of Draftperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens in view of Tap.

Stevens discloses the basic arrangement of the present invention. This includes a DC to DC converter that "generates" a second DC voltage from the first DC voltage. This DC-DC converter has a switching element and a control circuit that controls the switching element at "high" frequency. There is also a "means II"(Now called a "second circuit".) i.e. just a plain old conventional inverter that powers a lamp. How Stevens differs involves the specific arrangement of the DC source.

Tap discloses a specific arrangement of the DC source such that the first DC source, i.e. the battery is added to the "means I" (Now called a "first circuit".) that includes a transformer and this supplies the output load. The great advantage to adding the first DC source to the second involves the protection of such a circuit during a no load condition. With lamp circuits no load conditions are common. People have been known to remove lamps with the power still on. Also lamps have been known to break which provides a no-load condition. By unloading the

inverter the DC source also becomes un-loaded presenting a dangerous condition to the converter as recognized by Tap.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a DC source that adds the battery or first DC source voltage to the one that generates its DC voltage from the first DC source so as to protect against a no-load condition.

Applicant recites a "high-pressure discharge lamp" is employed. Stevens does not recite how much pressure are in his lamps. However, how "high" is "high"? Because of this and the fact that applicant does not set forth a range of pressures the pressure in Stevens lamps are seen being every much as high as that of applicant's. In any case, Stevens does recite that high intensity lamps are employed and it is well known that these have a higher pressure than your typical fluorescent lamp. Thus if applicant meant a lamp that has a higher pressure than the typical fluorescent lamp then clearly Stevens has such. If not given that Stevens discloses that an inverter can power a wide range of lamps, the use of a "high pressure" lamp clearly would have been obvious to one of ordinary skill for it would only be part of the workable range for that of Stevens.

Applicant also recites a "fly-back" arrangement for the DC-DC converter. Tap is seen as having such. However, fly-back arrangements for DC-DC converters are very conventional and conventional in the art. They are art recognized equivalents. As such the employment of such would have been obvious to one of ordinary skill in the art at the time the invention was made.

The title "Circuit arrangement"of the invention is clearly not descriptive. Every circuit is a "circuit arrangement" and this clearly does not provide any descriptive material as to the crux of the invention. A new title is required that is clearly indicative of the invention to which the claims are directed. (See MPEP 606.01).

Applicant's arguments filed 12-8-1997 have been fully considered but they are not persuasive.

As to applicant's belief that the prior art does not make obvious the claimed invention, this is respectfully disagreed with. Clearly, Tap discloses a DC-DC converter of conventional design where the battery or source voltage is added i.e. summed to another DC voltage. The motivation for using such a well known fly-back arrangement in Stevens is clearly presented in the previous and present office action.

It is immaterial to the issue of obviousness as to where or not applicant or applicant's representative knows how to modify Stevens with the structure of Tap. Applicant is respectfully reminded that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. See In re Bozek, 163 USPQ 545 (CCPA 1969), In re Mapelsden, 51 CCPA 1123, 329 F.2d 321, 141 USPQ 30 (1964) and In re Henley, 44 CCPA 701, 239 F.2d 3, 112 USPQ 56 (1956).

It is noted that applicant has not made any effort to comply with the requirement of the previous office action requiring that a title that is indicative of the invention be provided. Thus, this requirement is hereby repeated. If applicant continues to refuse to provide a title that is descriptive of the invention, applicant is request to present the reason why a "circuit arrangement" is considered to be indicative of the invention when a "circuit arrangement" is so very broad as to cover every circuit ever patented. How can this be indicative of the invention?

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-0956. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Michael Shingleton whose telephone number is (703) 308-4903.

MBS
Shingleton
February 27, 1998

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GROUP 2500